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34. The apparatus of claim 21, further comprising a means for depositing a sheet of material onto the coating material so that the hot melt adhesive adheres the sheet material to the coating material.

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Please cancel claims 11, 16, 17, and 27.

REMARKS

By this amendment, claims 10, 13, 15, 18, 19, 20, and 22 are amended, new claims 29-34 are added, and claims 11, 16, 17, and 27 are canceled to place this application in condition for allowance. Currently, claims 10, 12-15, 18, 22, 25, and 28-34 are before the Examiner for consideration on their merits.

First, a number of amendments have been made to the existing claims, including the addition of hot melt adhesive as the binder material, and the state of the coated material. In addition, new claims 29-34 are added to address the step of depositing a sheet of material on the hot melt adhesive. The new claims are supported by the specification, see particularly, page 8, lines 10-15.

In the outstanding Office Action, claims 10, 13-15, 17, 19-22, 25, 27, and 28 stand rejected under 35 U.S.C. § 102(b) based on British Patent No. 1,444,858 to Kasei. Remaining claims 11, 12, 16, and 18 stand rejected under 35 U.S.C. § 103(a) based on the combination of Kasei and previously cited Chen.

In response to the rejection based on Kasei, each of the independent claims has been amended to clarify one mode of the application. That is, the card is made to form a non-permanently magnetized component. Support for this aspect of the invention is found in the specification wherein a medium not normally having ferromagnetic properties, e.g., walls, wallpaper, cards, plastic sheets, etc., can retain a magnet, the very thing lacking in the

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prior art, see page 1, col. 10-16, page 5, line 5 to page 6, line 7, and page 9, lines 10-14. For example, a game board could hold a magnetic chess piece.

The independent claims have also been amended to recite that the binder is a hot melt adhesive, and the appropriate dependent claims have been canceled in this regard.

Turning now to the rejection, none of the rejections based on Kasei apply since each of the claims now recites a hot melt adhesive as the binder. Furthermore, the rejection based on Kasei and Chen is improper under the standards of 35 U.S.C. § 103(a).

In the rejection, the Examiner alleged that the use of hot melt adhesives is conventional and that the recitation of this limitation does not render the claim patentable. In support of this contention, the Examiner notes that Chen uses a hot melt adhesive as a binder.

Chen does not supply the motivation to use a hot melt adhesive in the process, apparatus, and film of Kasei. Referring to Figures 10 of Kasei, the purpose of the hot melt adhesive is to bind the absorbent composition 131 to the substrate 133. This binding occurs regardless of the presence of the iron oxide blended with the absorbent material. Referring to col. 12, lines 1-10, the same procedure as shown in Figure 10 was performed using an absorbent composition having no iron oxide powders, but still using the hot melt adhesive.

The procedure using the iron oxide resulted in more absorbent composition being applied to the substrate 133. However, the hot melt adhesive was not vital to the iron oxide; it was used regardless of the presence of the iron oxide.

Chen teaches that one can add iron particles to the absorbent composition and this addition allows for greater pickup of the absorbent composition when making the diaper. This does not translate into an omnibus teaching that hot melt adhesives are universal binders for iron oxide particles. In fact, since the hot melt adhesive is used in the absence of

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iron oxide particles, it could be said that Chen teaches that the iron oxide particles do not need their own adhesive; the adhesive used to make the diaper is sufficient.

Given Chen, Applicant strenuously submits that there is no motivation to use a hot melt adhesive in the Kasei invention. If anything, Kasei teaches using a solvent-based polymer to form a paste, and applies this paste with doctor knives. Based on this teaching, why would one use a hot melt adhesive? The answer to this question can only derive from the Applicant's own teachings, and this answer cannot be used to formulate the rejection since it is the improper use of hindsight.

Therefore, the rejection lacks the requisite motivation to combine Kasei and Chen, and a *prima facie* case of obviousness has not been established regarding method claim 10, and the product claim 15.

Kasei and Chen also fail to teach the method of new claims 29 and 31, wherein a sheet is applied to the hot melt adhesive. This step is totally missing from Kasei and Chen, and, even if combined, there is no suggestion of the method of claims 29 and 31.

Claim 20 is also distinguishable over Kasei, with or without Chen since Kasei does not teach means for applying a hot melt adhesive containing ferromagnetic particles to the medium. Kasei cannot anticipate this claim since it does not teach such means. At most, Kasei teaches applying a paste to a roller and controlling the thickness using doctor knives; no means are disclosed to dispense an adhesive that requires heat for its application.

The remaining question is whether Kasei, with or without Chen, establishes a *prima facie* case of obviousness against claim 20. The answer is no, since, as set forth above, there is no reason to use a hot melt adhesive in Kasei, so there would be no reason to supply means for its application. Therefore, claim 20 is also distinguishable over this reference.

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New claim 33 is also distinguishable over Kasei, with or without Chen, since there is no suggestion in either reference to deposit a sheet of material on the hot melt adhesive.

New claims 30, 32, and 34 parallel the limitations found in claims 29, 31, and 33, but are dependent on claims including the magnetizing aspect of the invention. Claims 30, 32, and 34 are patentable over Kasei/Chen for the same reasons as claims 29, 31, and 33.

Another argument in favor of the patentability of claims 10 and 15 is that Kasei does not teach forming a non-permanently magnetized component and attaching this component to a ferromagnetic object.

Kasei clearly makes a permanent magnetic film and does not teach each and every method step of claim 10, especially steps (c) and (d). Therefore, Kasei cannot anticipate claims 10 and 15 for this reason alone.

Moreover, there is no reason that one would use the product of Kasei before the magnetizing step is performed. To conclude that this is an obvious modification of Kasei is the use of hindsight based on Applicant's own disclosure. Thus, there is also no legitimate basis for a rejection based on 35 U.S.C. § 103(a), and claims 10 and 15 are patentable for this reason.

Lastly, Claims 12-14, 18, 19, 21, 22, and 23-25 are patentable by reason of their dependency on their respective independent claims.

Moreover, Kasei does not teach the use of the hot melt adhesive in making the permanent magnetized materials of claims 13, 18, 19, 21, and 22, and these claims are separately patentable over the applied prior art.

In summary, claims 10, 13, 15, 18-22, and 29-34 are all patentable over Kasei, with or without Chen for the reasons set forth above. These patents do not establish a *prima facie* case of anticipation or obviousness and these claims along with their respective dependent claims should be passed onto issuance.

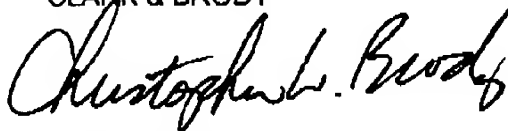
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If the Examiner believes that an interview would help expedite allowance of this application, the Examiner is invited to telephone the undersigned at 202-835-1753.

The above constitutes a complete response to all issues raised in the Office Action dated August 2, 2002. Again, reconsideration and allowance of this application is respectfully solicited.

Applicant petitions for a one month extension of time. Please charge the \$55.00 extension of time fee to Deposit Account No. 50-1088. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 50-1088, including any extension of time fees and claim fees.

Respectfully submitted,
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MARKED UP CLAIMS UNDER 37 CFR 1.121

10. (twice amended) A method of applying a coating to a surface of a medium to form a coated medium comprising the steps of:

a) providing a coating material by mixing a binder material suitable for being spread substantially and regularly over the surface and a ferromagnetic component, the binder material being a hot melt adhesive;

b) providing a medium having the surface to be coated, the surface capable of receiving a substantially and regularly spread coating material; and

c) spreading a substantially constant thickness of the coating material onto the surface and allowing the coating material to set to form the coated medium as a non-permanently magnetized component, wherein the medium that is coated is one of a paper, a card, wallpaper, a flexible plastic sheet, a rigid plastic sheet, and walls; and

d) magnetically and temporarily linking the non-permanently magnetized component [coated medium] to a ferromagnetic object so that the coated medium and ferromagnetic object are held together by magnetic attraction from the ferromagnetic object.

13. (twice amended) The method of claim 10, further comprising magnetizing the ferromagnetic component of the [coating material] non-permanently magnetized component so that the [coated material] non-permanently magnetized component remains magnetic after the magnetizing step such that the magnetized coated medium temporarily and magnetically holds the ferromagnetic object.

15. (twice amended) A coated medium comprising:

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a) a medium having a surface, the surface capable of receiving a substantially and regularly spread coating material, the medium being one of a paper, a card, wallpaper, a flexible plastic sheet, a rigid plastic sheet, and walls; and

b) a coating material as a mixture of a binder suitable for being spread substantially regularly over the surface of the medium and a ferromagnetic component, the coating material spread substantially and regularly over at least a portion of the surface, the binder material being a hot melt adhesive;

c) the [coated] coating material being applied to the medium to form a coated medium as a non-permanently magnetized component that can temporarily and magnetically link to a ferromagnetic object so that the [coated medium] non-permanently magnetized component and ferromagnetic object are held together.

18. (twice amended) The coated medium of claim [16] 15, wherein the adhesive is a hot melt adhesive and the mixture comprises two parts by weight of hot melt adhesive and six parts by weight of iron oxide as the ferromagnetic component.

19. (twice amended) The coated medium of claim 15, wherein the [ferromagnetic component] non-permanently magnetized component is permanently magnetized such that the magnetized coated medium temporarily and magnetically holds the ferromagnetic object.

20. (twice amended) An apparatus for coating a medium comprising:

a) means for mixing a binder suitable for being spread substantially regularly over a surface of the medium and a ferromagnetic component to form a coating material,

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wherein the medium is one of a paper, a card, wallpaper, a flexible plastic sheet, a rigid plastic sheet, and walls, the binder material being a hot melt adhesive; and

b) means for substantially and regularly spreading the hot melt adhesive containing the ferromagnetic component as the coating material onto the surface of the medium and for allowing the coating material to set, the mixing and spreading means forming a [coated medium] non-permanently magnetized component that can temporarily and magnetically link to a ferromagnetic object so that the coated medium and ferromagnetic object are held together.

21. (twice amended) The apparatus of claim 20, further comprising means for magnetizing the [coating material] non-permanently magnetized component so that the [coating material] non-permanently magnetized component remains magnetic after the magnetizing step such that the magnetized coated medium temporarily and magnetically can hold a ferromagnetic object.

22. (twice amended) The apparatus of claim 20, further comprising means for magnetizing the [coating material] non-permanently magnetized component so that the [coating material] non-permanently magnetized component remains magnetic after the magnetizing step such that the magnetized coated medium temporarily and magnetically can hold the ferromagnetic object, the magnetizing means having a magnetic strength to orient the ferromagnetic components of the coating material before the coating material sets.